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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/563,810

01/09/2006

Naoteru Honda

1422-0705PUS1

5357

2292 7590 04/01/2010  
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EXAMINER

MERCIER, MELISSA S

ART UNIT

PAPER NUMBER

1615

NOTIFICATION DATE

DELIVERY MODE

04/01/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/563,810	<b>Applicant(s)</b> HONDA ET AL.	
	<b>Examiner</b> MELISSA S. MERCIER	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 1-8-10.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Summary***

Receipt of Applicants Remarks, Amended Claims, and Declaration filed under 37 CFR 1.132 filed on January 8, 2010 is acknowledged. Claims 1 and 4-12 are pending in this application.

### ***Withdrawn Rejections/Objections***

#### ***Claim Rejections - 35 USC § 112***

The rejection of claims 1-5 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention has been withdrawn in view of Applicants amendments to the claims to clarify the claim language regarding the parts by weight, the antecedent basis for the term "the monoesters", and recitation of Markush groupings.

#### ***Claim Rejections - 35 USC § 102***

The rejection of claims 1-5 under 35 U.S.C. 102(a) and (e) as being anticipated by Hojo et al. (US Patent 7,264,834) has been withdrawn in view of Applicants amendment to the claims to recite a diglycerol fatty acid ester and further in view of Applicants Declaration filed under 37 CFR 1.132 which shows different functional properties of the disclosed polyglycerol fatty acid esters of Hojo and the diglycerol fatty acid esters of the instant claims.

The rejection of claims 1 and 4-5 under 35 U.S.C. 102(a) and (e) as being anticipated by Hojo et al. (US Patent 6,808,726) has been withdrawn in view of Applicants incorporation of claims 2 and 3 into claim 1.

The rejection of claims 1-5 under 35 U.S.C. 102(b) as being anticipated by Nanbu et al. (US Patent 6,074,675) has been withdrawn in view of Applicants amendment to claim 1.

### ***Newly Applied Rejections/Objections***

#### ***Claim Objections***

Claim 5 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claim 5 comprises language related to future intended use of the composition and does not contain any additional structural limitations to distinguish itself from claim 1.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 4-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamoto et al. (US 2003/0021994).

Kawamoto discloses an ultra fine particle dispersion comprising ultra fine particles having an average particle size of 10-60nm in a plasticizer (abstract). The particles can be zinc oxide (paragraph 0021). The disperability of the particles can be improved by the addition of a dispersing agent, which is preferably a polyglycerol fatty acid ester such as deglycerolize monolaurate, diglycerol monopalmitate, diglycerol monopalmitate, diglycerol monostearate, for example (paragraph 0029). It is noted that Applicants has identified these polyglycerol fatty acid esters as those which meet the functional and structural limitations recited in the instant claims.

Regarding claim 7, the use of enzymatic ally decomposed lecithins is not disclosed, thereby meeting the limitation of the claim.

While it is acknowledged the specific combination of components is not exemplified and the use of the polyglycerol fatty acid ester is an additional component and not a required component of the Kawamoto reference, it is disclosed as suitable for use. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the dispersing agent into the composition of Kawamoto since he disclosed it allows for the improved ability to form a homogenous dispersion.

The instant claims differ from the references only in the specific percentage selected for the compositions. However, It would have been deemed prima Facie obvious to one having ordinary skill in the art at the time of the invention to optimize the

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amount of the dispersing agent, to prepare a composition containing ultra fine particles is well within the level of one having ordinary skill in the art, and the artisan would be motivated to determine optimum amounts to get the maximum effect of the active compounds. Therefore, the invention as Whole has been prima face obvious to one of ordinary skill in the art at the time the invention was made.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MELISSA S. MERCIER whose telephone number is

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(571)272-9039. The examiner can normally be reached on 8:00am-4:30pm Mon through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Wax can be reached on (571) 272-0623. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melissa S Mercier/  
Examiner, Art Unit 1615

/Robert A. Wax/  
Supervisory Patent Examiner, Art Unit 1615